

REMARKS / DISCUSSION OF ISSUES

Claims 22-23, 28-32, and 37-55 are pending in the application. Claims 51-55 are newly added. No new matter is added.

Claims 28 and 37 are amended for non-statutory reasons: to correct a typographical error. The claims are not narrowed in scope and no new matter is added.

The Office action rejects:

claims 22-23, 28, 30-32, 37, 42-44, and 46-50 under 35 U.S.C. 103(a) over van der Schaar et al. (USP 6,788,740, hereinafter Schaar), Furukawa et al. (USP 6,804,827, hereinafter Furukawa), Guedalia (USP 6,536,043), and Carr (USP 7,051,357);

claim 45 under 35 U.S.C. 103(a) over Schaar, Furukawa, Guedalia, Carr, and Tracton (USP 6,470,378); and

claims 29, 38, and 49 under 35 U.S.C. 103(a) over Schaar, Furukawa, Guedalia, Carr, and Terui (USP 6,986,158).

The applicant respectfully traverses these rejections.

Claim 22, upon which claims 23, 28-30, and 51-52 depend, claims a method that includes processing a plurality of broadcast signals into a corresponding plurality of surfing signals that provide, at most, a second quality level that is substantially poorer than the first quality level, and broadcasting the plurality of surfing signals to enable channel surfing of the surfing signals at a remote device at a time of surfing that is not substantially different from a time of broadcasting the corresponding broadcast signals. Independent claims 31 and 42, upon which claims 32-38, 43-50, and 53-55 depend, include similar limitations.

The Examiner's attention is requested to MPEP 2143, wherein it is stated:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). ... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)".

The courts have consistently upheld that the claimed combination must be suggested by the prior art, rather than by the applicant's specification:

"When prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must *suggest* the desirability, and thus the obviousness, of making the combination. *It is impermissible to use the claims as a frame and the prior-art references as a mosaic to piece together a facsimile of the claimed invention.*" (emphasis added) *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art *suggested* the desirability of the modification." (emphasis added) *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

There is no suggestion in the prior art to combine the teachings of Schaar, Furukawa, Guedalia, and Carr, absent the applicant's teachings. The mere fact that four references are required to derive the limitations of the applicant's claimed invention argues against the fact that the prior art suggests such a combination. None of these references teach or suggest broadcasting poorer quality video to facilitate channel surfing, and none of these references teach or suggest the desirability of such broadcasting of poorer quality video to facilitate channel surfing. The only suggestion to broadcast poorer quality video to facilitate channel surfing comes from the applicant's specification.

The Office action asserts that the motivation to combine Schaar and Furukawa is to ensure "that a user does not experience incongruities when changing the channel to one of a different provider" (Office action, page 5, lines 3-7). However, the applicant respectfully notes that Schaar does not teach providing multiple channels, and therefore there is no need for Furukawa's incongruity-preventing teachings in

Schaar's system. One of ordinary skill in the art would not be lead by either Schaar or Furukawa to combine their teachings, because they each address situations that are unrelated to each other, and neither teaches the desirability of such a combined embodiment.

The Office action acknowledges that the "combination of der Schaar, Furukawa and Guedalia does not disclose surfing a plurality of channels", and asserts that the motivation to combine the teachings of Carr with this combination is "for the advantage of providing additional information about a program to a user and saving bandwidth through the use of IP multicasting". Although this motivation may exist, the requirement of MPEP 2143 is that motivation indicates the desirability of the claimed invention, and Carr's providing additional information about a program to a user and saving bandwidth through the use of IP multicasting is unrelated to the applicant's claimed invention.

Because there is no suggestion in the prior art to combine Schaar and Furukawa, and because the prior art does not suggest the desirability of the applicant's claimed invention by combining Schaar, Furukawa, Guedalia, and Carr, the applicant respectfully maintains that the rejections of claims 22-23, 28-32, 37-38, and 42-50 under 35 U.S.C. 103(a) based on this combination are unfounded, per MPEP 2143.

Assuming in argument that the proposed combination of Schaar, Furukawa, Guedalia, and Carr is made, the Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The proposed combination of Schaar, Furukawa, Guedalia, and Carr does not teach or suggest processing each of a plurality of broadcast signals into surfing signals of a corresponding plurality of surfing signals that provide, at most, a second quality level that is substantially poorer than the first quality level, and broadcasting the plurality of surfing signals to enable channel surfing of the surfing signals, as claimed in each of the independent claims 22, 31, and 42.

The Office action acknowledges that the combination of Schaar and Furukawa does not teach generating signals at a second quality level that is substantially poorer than the first quality level, and asserts that Guedalia provides this teaching. The applicant respectfully disagrees with this assertion.

Guedalia teaches the use of two time scales to allow the viewing of streaming video on channels of different bandwidth. Guedalia provides this system to facilitate the transmission of high quality images regardless of bandwidth. In Guedalia, users that have high bandwidth access receive the high quality images quickly; users that have a lower bandwidth are provided a progressive scheme that creates the high quality images incrementally: "receipt of subsequent blocks by the receiver being used to cumulatively improve the quality of the digital data viewed by the receiver" (Guedalia's Abstract, last sentence). Guedalia specifically teaches:

"the lower bandwidth client receives lower quality media than the higher bandwidth client at first. As the media is replayed in the foreground and the bandwidth is freed, more data streams in via background, and the quality of the media is enhanced." (Guedalia, column 2, line 65 – column 3, line 2.)

And, "Using the technology of the present invention, producers can deliver high resolution images over the Internet for rapid interactive gazing." (Guedalia, column 3, lines 48-50.)

And, "The representation is two-dimensional, with one dimension (block number) being characterized by progressiveness in quality, and the second dimension (frame number) being characterized by interactivity." (Guedalia, column 3, lines 56-60.)

That is, Guedalia specifically teaches transmitting a high quality image, but in a manner such that a lower bandwidth system can progressively improve the quality of the image.

Because Guedalia fails to teach providing surfing signals that provide, at most, a quality level that is substantially poorer than the broadcast quality level, as specifically claimed in each of claims 22, 31, and 42, the applicant respectfully maintains that the rejections of claims 22-23, 28-32, 37-38, and 42-50 under 35 U.S.C. 103(a) that rely on Guedalia for providing this teaching are unfounded, per MPEP 2142.

The Office action rejects claims 39-41 under 35 U.S.C. 103(a) over Tracton and Quicktime (<http://web.archive.org/web/19990508141539/http://www.apple.com/quicktime/showcase/live/>). The applicant respectfully traverses this rejection.

Claim 39, upon which claims 40 and 41 depend, claims a portable device that includes a browser that accesses each of a plurality of Internet addresses at a given rate, to provide thereby sequential images corresponding to each broadcast channel associated with each Internet address.

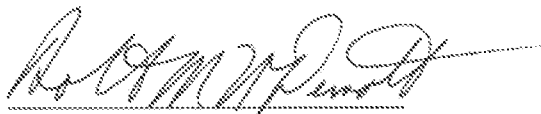
The Office action asserts that Tracton teaches a browser that accesses each of a plurality of Internet addresses at a given rate, but fails to provide support for this assertion.

The Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a *prima facie* case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art (see, for example, *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005)).

Because the Office action has failed to identify where the prior art teaches a browser that accesses each of a plurality of Internet addresses at a given rate, the applicant respectfully maintains that the Office action has failed to establish a *prima facie* case, and respectfully maintains that the rejection of claims 39-41 under 35 U.S.C. 103(a) are unfounded, per MPEP 2142.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Robert M. McDermott, Esq.
Registration Number 41,508
Phone: 804-493-0707
Fax: 215-243-7525

Please direct all correspondence to:
Larry Liberchuk, Esq.
Philips Intellectual Property and Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9618
Fax: (914) 332-0615